

REMARKS

By this Amendment, Applicants have amended claims 1, 8, 22, and 29 and added new claims 56-59 such that claims 1-3, 5-11, 22-24, 26-32, and 56-59 remain pending in this application. Support for Applicants' claim amendments and new claims can be found in Applicants' specification at, for example, pages 11-13.

In the Office Action dated June 3, 2005, the Examiner rejected claims 1-3, 5-11, 22-24, and 26-32 under 35 U.S.C. § 103(a), as being unpatentable over Walker et al. (US 6,487,291) in view of Khoury et al. (US 6,665,396). Applicants respectfully traverse the rejections of claims 1-3, 5-11, 22-24, and 26-32 under 35 U.S.C. § 103(a) for the reasons below.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

Independent claim 1 as amended, recites, among other things:

retrieving, when the customer provides the identification number, customer information about the customer based on the provided identification number;

computing a customer prioritization score based on the retrieved customer information, wherein computing the customer prioritization score comprises determining whether the retrieved customer information includes a predetermined amount of customer information;

Walker et al., contains no disclosure or suggestion of at least "retrieving, when the customer provides the identification number, customer information about the

customer based on the provided identification number,” and “computing a customer prioritization score based on the retrieved customer information, wherein computing the customer prioritization score comprises determining whether the retrieved customer information includes a predetermined amount of customer information.” Further, Walker et al. fails to teach or suggest “prioritizing the customer inquiry based on the computed customer prioritization score and the determination of whether the retrieved customer information includes the predetermined amount of customer information,” as recited in claim 1.

By contrast, Walker et al. is directed to a system which enables the position of a call in a queue to be moved within the queue according to criteria. (Col. 2:48-51). A caller is questioned to obtain data regarding the subject of the call (e.g., the quantity of items being ordered, a catalog number, etc.). (Col. 3:38-58). Based on the data provided by the caller regarding the subject of the call, as well as customer status information, an economic value is assigned to the call. (Col. 3: 58-60).

In the Office Action on page 4, the Examiner states that “[i]t is maintained that even though Walker does not positively disclose that customers have stored personal records that are retrieved upon reception of an inquiry, it is *clear* that such is suggested. The above teaching by Walker could not be accomplished *unless* customer records were stored and retrieved in order to affect the caller economic value.”

Applicants traverse the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). “To establish inherency, the extrinsic evidence ‘must make clear that the

missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Applicants therefore respectfully submit the Examiner provide a basis or technical reasoning to show that "the teachings by Walker could not be accomplished *unless* customer records were stored and retrieved in order to affect the caller economic value," as cited on page 4 of the Office Action.

Accordingly, Walker et al. fails to disclose or suggest "retrieving, when the customer provides the identification number, customer information about the customer based on the provided identification number," as recited in claim 1 and similarly recited in independent claim 22.

Furthermore, there is no disclosure or suggestion in Walker et al. of "computing a customer prioritization score based on the retrieved customer information, wherein computing the customer prioritization score comprises determining whether the retrieved customer information includes a predetermined amount of customer information; and prioritizing the customer inquiry based on the computed customer prioritization score and the determination of whether the retrieved customer information includes the predetermined amount of customer information." The Walker et al. system assigns an economic value to a call **without** any determination of "whether the retrieved

customer information includes a predetermined amount of customer information.” The Walker system therefore, does not “prioritize[e] the customer inquiry based on the computed customer prioritization score **and** the determination of whether the retrieved customer information includes the predetermined amount of customer information,” since it assigns the economic value **without any regard to** “whether the retrieved customer information includes a predetermined amount of customer information.”

Therefore, Walker et al. fails to disclose or suggest “retrieving, when the customer provides the identification number, customer information about the customer based on the provided identification number,” and “computing a customer prioritization score based on the retrieved customer information, wherein computing the customer prioritization score comprises determining whether the retrieved customer information includes a predetermined amount of customer information.” Further, Walker et al. fails to teach or suggest “prioritizing the customer inquiry based on the computed customer prioritization score and the determination of whether the retrieved customer information includes the predetermined amount of customer information.” Such features are recited in claim 1 and similarly in claim 22.

Khoury et al., cited to show associating a customer input with his/her respective account, fails to cure the above noted deficiencies of Walker et al. Therefore, Walker et al. and Khoury et al., whether taken alone or in combination, fail to disclose or suggest all of the elements of claims 1-3, 5-11, 22-24, 26-32, and 56-59. The Examiner has, therefore, not met an essential criteria for establishing a *prima facie* case of obviousness. See M.P.E.P. §§ 2142, 2143, and 2143.03.

Therefore, Applicants respectfully submit that independent claims 1 and 22 are allowable, for the reasons argued above. In addition, dependent claims 2-3, 5-11, 23-24, 26-32, and 56-59 are also allowable at least by virtue of their respective dependence from allowable base claims 1 and 22. Therefore, Applicants respectfully submit that the Examiner should withdraw the 35 U.S.C. § 103(a) rejection.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-3, 5-11, 22-24, 26-32, and 56-59 in condition for allowance. Applicants submit that the proposed amendments of claims 1, 8, 22, and 29 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.


In view of the foregoing remarks, Applicants submit that the claims are neither anticipated nor rendered obvious in view of the prior art references cited in the Office Action. Applicants, therefore, request the Examiner's reconsideration and reexamination of the application, and the timely allowance of all of the pending claims. Allowance of the pending claims is deemed appropriate and respectfully requested.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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